



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

September 5, 2003

Hon. Commissioner of Patents and Trademarks
Washington DC 20231

Applicant: Steven A. Benner
Title: Evolution-based Functional Genomics
Serial number: 09/640709
Filing date: August 18, 2000
Examiner: Michael Borin

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Steven A. Benner (Applicant)

This is a verified statement that the Applicant is a "small entity" as defined by 37 CFR 1.27. The Applicant is a holder of Deposit Account Number 02-2055 in the Applicant's name, and authorizes the Commissioner to debit any charges or credit any overpayment to this account as appropriate.

Dear Sir:

This communication is responsive to an Office Action mailed August 7, 2003, Paper 5 in the case.

RESPONSE

In August, 2000, the above cited application was filed with a single claim:

1. A method for constructing hypotheses concerning the function of protein families based on an analysis of the non-stochastic behavior of sequence evolution.

This claim was only one that might be based on the specification, and perhaps the broadest that might be so based.

In Paper 3, sent on November 27, 2002, the Examiner objected to the breadth and indefiniteness of the claim, and the possibility that the claim might not be drawn to statutory material. In particular, the claim was objected to because it contained "no positive method steps", because "constructing hypotheses" may not be statutory. The Examiner rejected the claim based on his arguments, which the applicant found in large part persuasive for the particular claim.

Responsive to the Examiner's objections, the rejected claim was cancelled, and several new claims were presented. This response was dated May 25, 2003. Each of the new claims contained positive steps, responding to an objection made by the Examiner for the original claim. None of the new claims were directed towards the process of constructing hypotheses, also responding to an objection made by the Examiner for the original claim. Each of the new claims is clearly directed against statutory material. Each of the new claims is supported by the

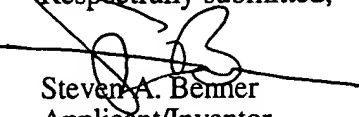
specification. Each of the new claims was related to the elected invention. None of the new claims are distinct from the invention originally claimed.

Thus, the response would appear to be fully responsive to the Office Action (Paper 3). In the prosecution of a patent, it is entirely permissible (indeed, it is commonly done) to cancel a claim to which the Examiner has objected, and to replace it with narrower claims that are not susceptible to objections raised by the Examiner.

For this reason, the Applicant respectfully traverses the response (Paper 5) mailed August 7, 2003.

The Applicant respectfully requests that the Examiner examine the claims presented in his response dated May 25, 2003. Again, these claims were drafted as revisions of the original claim in a bona fide attempt to construct claims that would not suffer from the defects mentioned by the Examiner that led him to reject the claim originally submitted.

Respectfully submitted,



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